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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,630	01/25/2002	Ronald M. Burch	200.1079CON5	3300

7590 07/10/2007  
Davidson, Davidson & Kappel, LLC  
14th Floor  
485 Seventh Avenue  
New York, NY 10018

EXAMINER
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GROSS, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1639

MAIL DATE	DELIVERY MODE
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07/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/057,630

Applicant(s)

BURCH ET AL.

Examiner

Christopher M. Gross

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 29 January 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

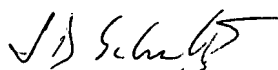
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 38,47-53.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
J. DOUGLAS SCHULTZ, PH.D.  
SUPERVISORY PATENT EXAMINER

## **ADVISORY ACTION**

### **Continuation of 7 and 11**

Claims 38, 47-48, 50-53 remain rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,569,937 (Baker et al) and Swingle et al (Drugs Exptl. Clin. Res. Vol. X(8-9) (1984) pages 587-597) and/or Rabasseda. (Drugs of Today Vol. 32, No. 5 (1996) pages 365-384) for the reasons of record.

Claim 49 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al (US patent 4,569,937), Swingle et al. and/or Rabasseda as applied to claims 38, 47-48, and 50-53 above, and further in view of Oshlack et al. US Pat. No. 5,472,712 (12/95) or Oshlack et al. US Pat. No. 6,294,195 (9/01: effectively filed 10/93 or earlier) for the reasons of record.

### **Response to Arguments**

Applicant argues, see p 6 (1/29/2007), (i) there is a lack of motivation in combining Baker et al with Swingle et al or Rabasseda because the suggestion cited by the Examiner in the last office action is taken out of context and (ii) that the use of ibuprofen by Baker et al teaches away from the claimed invention.

(i) Specifically, applicant argues, see p 6 (1/29/2007) when Baker states "[t]his patent discloses that the analgesic effect of the combination of a selected non-steroidal antiinflammatory drug (NSAID) and a selected narcotic analgesic is greater the for either alone," Baker not referring to the Baker patent itself, but rather US Patent 5,464,376, issued to Sunshine et al. Applicant further argues that Sunshine et al teach the beneficial properties of caffeine with NSAIDs and caffeine with narcotic analgesics

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whereas the amended claims are closed to other active ingredients, being drawn to two analgesic compounds consisting of nimesulide and oxycodone.

Assuming *arguendo*, that the suggestion of Baker is indeed referring to caffeine through Sunshine et al, it is the Examiner's position that motivation still remains to substitute nimesulide for ibuprofen in the combination of ibuprofen plus oxycodone per Baker, based on the favorable properties of nimesulide regarding gastrointestinal tolerance (see Office Action mailed 9/29/2005 p 5) as well as the fact that the claimed subject matter represents substituting art recognized equivalents known for the same purpose (see MPEP 2144.07).

(ii) Applicant argues, see 8-13 (1/29/2007), Baker et al teaches away from the claimed subject matter by only teaching ibuprofen yet nowhere does Baker disparage the nimesulide advocated by Swingle et al or Rabasseda, and according to *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004), "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...."